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EXAMINER

RODRIGUEZ, RUTH C

ART UNIT PAPER NUMBER

3677

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,982

Applicant(s)

SO, DAVID

Examiner

Ruth C Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 8-10, 12, 15, 16, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 3-7 and 16-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings were received on 28 January 2005. These drawings are disapproved. These drawings contain new matter because the drawings have four lower girdle facets instead of three lower girdle facets between each adjacent pair of the pavilion main facets where at least one of the lower girdle facets being rotated such that the at least one lower girdle facet is not tangent to a circumference about the stone.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, three lower girdle facets between each adjacent pair of the pavilion main facets where at least one of the lower girdle facets being rotated such that the at least one lower girdle facet is not tangent to a circumference about the stone must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the

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remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 8, 9, 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 8 and 19 recite a limitation stating "three lower girdle facets between each adjacent pair of said pavilion main facets; wherein at least one of said lower girdle facets is rotated so that said at least one lower girdle facet is not tangent to a circumference about said stone." It is unclear how three lower girdle facets are between each adjacent pair of pavilion main facets where at least one of the lower girdle facets is rotated so

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that the at least one lower girdle facet is not tangent to a circumference about the stone since the rotation of the at least one lower girdle facet will create an additional facet and there will be four facets instead of the three facets claimed. For purpose of examination, the Examiner is assuming that the rotated lower girdle facet being rotated will not be in the same plane as the other two lower girdle facets and that the rotated lower girdle facet will be at an angle with respect to the other two lower girdle facets.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 8-10, 12, 14, 15, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Fine (US D141,259).

Fine disclose a cut stone comprises a pavilion portion having a culet, a crown portion and a girdle separating the pavilion portion from the crown portion, a plurality of bezel facets and three upper girdle facets (Figs. 1-3). A plurality of pavilion main facets extends between the girdle and the culet. Three lower girdle

facets between adjacent pavilion main facets (Figs. 1-3). Each of the three lower girdle facets has a top side along the girdle (Figs. 1-3). Only two lower girdle facets have a common lower vortex extending toward the culet and a third lower girdle facet has a separate lower vertex extending towards the culet (Figs. 1-3). The bezel facets extend between the girdle and the table (Figs. 1-3). The three upper girdle facets are between adjacent bezel facets (Figs. 1-3). Each of the three upper girdle facets has a bottom side along the girdle (Figs. 1-3). Two of the upper girdle facets have a common upper vertex extending towards the table (Figs. 1-3). Fine fails to disclose that each of the three upper girdle facets has a common upper vertex extending towards the table. However, it would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to have each of the three upper girdle facets has a common upper vertex extending towards the table instead of having two of the upper girdle facets with a common upper vertex extending towards the table since such a modification would have involved a mere change in the size of a component. A change in the size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Especially since the applicant fails to disclose that this change would result in any unexpected result and such changes are considered routine in order to enhance the appearance of the gemstone.

The crown disclosed by Fine includes a plurality of star facets encircling the table and a bezel facet between adjacent star facets and the girdle (Figs. 1-3).

A cut stone comprises a pavilion portion having a culet, a crown portion and a girdle separating the pavilion portion from the crown portion (Figs. 1-3). A plurality of pavilion main facets extends between the girdle and the culet (Figs. 1-3). Three lower girdle facets are between each adjacent pair of the pavilion main facets (Figs. 1-3). At least one of the lower girdle facets is rotated so that the at least one lower girdle facet is not tangent to a circumference about the stone (Figs. 1-3).

Fine also disclose that a middle of the three lower girdle facets is the rotated lower girdle facet (Figs. 1-3).

Fine disclose a cut stone comprises a pavilion portion having a culet, a crown portion having a table with a predetermined number of sides and a girdle separating the pavilion portion from the crown portion (Figs. 1-3). Three lower girdle facets for each side of the table (Figs. 1-3). Each of the three lower girdle facets have a top side along the girdle and only two lower girdle facets have a common lower vortex extending toward the culet (Figs. 1-3). Three upper girdle facets for each side of the table (Figs. 1-3). Each of the three upper girdle facets has a bottom side along the girdle and an upper vertex extending toward the table (Figs. 1-3). Two of the upper girdle facets have a common upper vertex extending towards the table (Figs. 1-3). Fine fails to disclose that each of the three upper girdle facets has a common upper vertex extending towards the table. However, it would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to have each of the three upper girdle facets has a common upper vertex extending towards the

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table instead of having two of the upper girdle facets with a common upper vertex extending towards the table since such a modification would have involved a mere change in the size of a component. A change in the size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Especially since the applicant fails to disclose that this change would result in any unexpected result and such changes are considered routine in order to enhance the appearance of the gemstone.

Fine discloses a method for cutting a stone comprises forming a pavilion portion having a culet; forming a crown portion having a table with a predetermined number of sides; forming a girdle separating the pavilion portion and the crown portion; forming three lower girdle facets between pairs of pavilion main facets so that each of the three lower girdle facets have a top side along the girdle and only two lower girdle facets have a common lower vertex extending towards the culet; and forming three upper girdle for each side of the table so that each of the upper girdle facets have a bottom side along the girdle and two of the upper girdle facets have a common upper vertex extending towards the table and the remaining upper girdle facet has a vertex extending towards the table (Figs. 1-3). Fine fails to disclose that each of the three upper girdle facets has a common upper vertex extending towards the table. However, it would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to have each of the three upper girdle facets has a common upper vertex extending towards the table instead of having two of the upper girdle facets with a common upper vertex extending towards the

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table since such a modification would have involved a mere change in the size of a component. A change in the size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Especially since the applicant fails to disclose that this change would result in any unexpected result and such changes are considered routine in order to enhance the appearance of the gemstone.

Fine discloses a method for cutting a stone comprises: forming a crown portion having a table; forming a pavilion portion having a culet; forming a girdle separating the crown portion from the pavilion portion; forming a plurality of bezel facets extending between the girdle and the table; forming a plurality of pavilion main facets between the culet and the girdle; forming three upper girdle facets between adjacent bezel facets so that two of the upper girdle facets have a common vertex extending towards the table and each of the three upper girdle facets have a bottom side along the girdle; and forming three lower girdle facets between adjacent pavilion main facets so that each of the three lower girdle facets has a top upper side along the girdle where only two lower girdle facets have a common lower vertex extending towards the culet and a third lower girdle facet has a separate lower vertex extending towards the culet (Figs. 1-3). Fine fails to disclose that each of the three upper girdle facets has a common upper vertex extending towards the table. However, it would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to have each of the three upper girdle facets has a common upper vertex extending towards the table instead of having two of the upper

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girdle facets with a common upper vertex extending towards the table since such a modification would have involved a mere change in the size of a component. A change in the size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Especially since the applicant fails to disclose that this change would result in any unexpected result and such changes are considered routine in order to enhance the appearance of the gemstone.

The method disclosed by Fine further comprises forming a table on the crown with a plurality of sides; forming a star facet extending from each side of the table; and forming bezel facets between the star facets (Figs. 1-3). Each of the bezel facets extends from a lower vertex at the girdle to an upper vertex at the table (Figs. 1-3).

Fine also discloses that a method for cutting a stone comprises forming a crown portion, forming a pavilion portion including a culet, forming a girdle separating the crown portion from the pavilion portion and forming a lower girdle facet on the pavilion portion rotated not to be tangent to a general circumference of the stone (Figs. 1-3).

Fine also discloses that the method further comprises forming multiple lower girdle facets on the pavilion portion rotated to not be tangent to the general circumference of the stone (Figs. 1-3).

Allowable Subject Matter

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7. Claims 3-7 and 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

- Regarding to claim 3, Markowitz discloses a cut stone comprises a pavilion portion having a culet, a crown portion and a girdle separating the pavilion portion from the crown portion (Figs. 2-4). A plurality of pavilion main facets extends from near the culet toward the girdle (Figs. 2-4). The pavilion main facets vary in width (Figs. 2-4). The stone has an oval cut (Figs. 2-4). Markowitz fails to disclose that the stone has a round cut. The prior art of record also fails to disclose a cut stone having a plurality of pavilion main facets varying in width where the stone has a round cut. Accordingly, it would not have been obvious to one having ordinary skill in the art at the time of applicant's invention to have a cut stone having a plurality of pavilion main facets varying in width where the stone has a round cut.

- For claim 16, the same reasons for allowance of claim 3 will apply to claim 16 since claim 16 is the method for cutting a stone where the stone has all the features recited in claim 3.

Response to Arguments

9. Applicant's arguments filed 28 January 2005 have been fully considered but they are not persuasive.

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10. The Applicant argues that the patent document by Fine fails to teach or suggest that the stone has three upper girdle facets having a common vertex. This argument fails to persuade. The disclosure of the application fails to provide any criticality to the fact that there are three upper girdle facets having a common vertex. The disclosure only provides support for having more than two upper girdle facets. The Examiner acknowledges that the patent reference by Fine fails to disclose that the stone has three upper girdle facets having a common vertex, however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have change the size of the upper girdle facet located in the middle because such a change is considered a routine modification in order to improve the appearance of the stone.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kraus (US D59,234), Heller (US D140,283), Fine (US D141,258 and US D141,259), Westreich (US D204,199), Polakiewicz (US 3,763,665), Bachar (US D392,590), Itzkowitz (US 5,713,219), Fajerstein (US D437,671), Cheng (US D453,120), Tolkowsky (US D455,367), Rydlewicz (US D459,676), Kagaya (US D460,378), Cohen (US D460,711), Greeff (US D463,315), Tolkowsky (US D483,290), Markowitz (US 6,668,585) and Mehta (US D490,014) are cited to show state of the art with respect to cut stones having some of the features being claimed by the current application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (703) 308-1881 until 31 March 2005 and the telephone number is (571) 272-7070 after 01 April 2005. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (703) 306-4115.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ruth C. Rodriguez
Patent Examiner
Art Unit 3677

RCR
rcr

March 7, 2005


ROBERT J. SANDY
PRIMARY EXAMINER